IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/627,345
Applicant	:	George R. Borden, IV
Conf. No.	:	2320
Filed	:	July 25, 2003
TC/A.U.	:	2173
Examiner	:	Michael Roswell
Docket No.	:	SLA1182 (7146.0153)
Customer No.	:	55648
Title	:	AURAL USER INTERFACE

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

REQUEST FOR REHEARING

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June 30, 2009

Sir:

In response to the Decision on Appeal of May 6, 2009, the applicant requests that the Board rehear the applicant's appeal, for the reasons given below.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN THE APPLICATION

There are 20 claims currently pending in the application.

B. STATUS OF ALL CLAIMS

Claims canceled:	1-10
Claims withdrawn:	None
Claims pending:	11-30
Claims allowed:	None
Claims objected to:	None
Claims rejected:	11-30

C. CLAIMS ON APPEAL

Claims 11-30 are on appeal.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection presented for review are: (1) whether claims 11, 12, 15, 16, 19-22, 25, 26, 29, and 30 are unpatentable under 35 U.S.C. §102(a) as being obvious over the combination of Vallone et al., U. S. Patent No. 6,642,939 (hereinafter Vallone) in view of Peterson et al., U.S. Patent No. 5,652,714 (hereinafter Peterson), and IBM Research Disclosure Number 41878, cited in the Examiner's office action dated July 25, 2006 (hereinafter IBM-41878); (2) whether claims 13, 14, 23, and 24 are unpatentable under 35 U.S.C. §103(a) over the combination of Vallone in view of Petersen and IBM-41878, and in further view of Auflick et al., U.S. Patent No. 6,820,238 (hereinafter Auflick); and (3) whether claims 17, 18, 27, and 28 are unpatentable under 35 U.S.C. §103(a) over the combination of Vallone, Peterson, IBM-41878, and in further view of McKiel Jr., U.S. Patent No. 5,287,102.

ARGUMENT

In a decision dated May 6, 2009, the Board of Patent Appeals and Interferences (Board) affirmed the Examiner's rejection of claims 11-30 in this patent application. The decision of the Board indicated that an argument first raised by the applicant in its Reply Brief was untimely, and hence not considered by the Board when rendering its decision. As explained below, the Board's refusal to consider this argument contradicts the Manual of Patent Examining Procedure (MPEP) Section 1208, *which expressly contemplates that an applicant may raise new issues in a reply brief*, and if so, an Examiner is permitted to file a Supplemental Answer addressing the newly raised arguments. In this particular case, the Examiner elected *not* to respond to the applicant's argument. Accordingly, the applicant requests that the Board reconsider the full arguments presented, and reverse the Examiner's rejection of claims 11-30.

In a Reply Brief filed May 11, 2007, the applicant raised an argument that the Examiner's rejection of claims 11-30 under 35 U.S.C. § 103(a) was improper because the Examiner had misread the secondary reference Peterson, U.S. Patent No. 5,652,714. Each of the applicant's claims are broadly directed to an interface by which a user may navigate though a hierarchy of data by listening to audible signals that indicatc where, within that data set, a current selection is positioned relative to the entire data set. In particular, each of the applicants claims define a "first aural signal" associated with a "first input" and a "second aural signal" associated with a "second input" where the first signal has an audible characteristic indicating upward navigation and the second signal has an audible characteristic that indicates down ward navigation. These first and second characteristics are required by the claims to be different, e.g., the first signal may include a spoken word "up" and the second signal may include the spoken word "down", or the first signal may sound like a chime, where the second signal sounds like a knock, etc.

As conceded by the Examiner, the primary reference, Vallone fails to disclose first and second signals with different characteristics respectively representing upwards and downwards navigation. Vallone discloses a TIVO navigation guide with a remote where transitional sounds may be used to indicate that a user of the remote is moving a highlight bar to another area and where warning sounds may indicate that a requested movement is not permitted. Vallone does not indicate that the transitional sound when navigating upwards through a hierarchical structure

is different from the transition sound when moving downwards. Hence the transitional sound of Vallone merely indicates movement through a hierarchical structure and does not indicate movement upwards or downwards.[1] Similarly, the warning sound does not indicate movement upwards or downwards.

The Examiner, however, does contend that this limitation is disclosed by Peterson, U.S. Patent No. 5,652,714 at col. 27 lines 31-35 and 43-52. The applicant noted in its reply brief that the Examiner's reading of Peterson is erroneous. Petersen discloses a software tool capable of editing transitions between "states" in interactive multimedia presentations. For example, one multimedia presentation may display an image of a dog in two states: a first state sitting and a second state standing. Peterson also indicates that the multimedia presentation may include "transitions" between the states, i.e. in the foregoing example, a series of frames showing the dog rising from a sitting position when moving from state 1 to state 2, or a separate series of frames showing the dog sitting from a standing position when moving from state 2 to state 1. Peterson's software tool has a window, shown in FIG. 22 allowing a user display the transitions by moving between the states after pressing an appropriate one of "return to previous state" button or "a "transit to next state" button.

In the passage cited by the Examiner, Peterson discloses that "the playback of a transition includes the transient event(s) associated with the transition. For example, *if* a sound is associated *with the transition*, then the sound is played in substantially the same way as it would be played in the user's view window."(emphasis added). Thus, Peterson is merely indicating that, if the transition between the dog sitting and standing includes the dog barking, then when a user of the editing software presses the "transit to next state" button from state 1, the sound of the dog barking will be heard. The Examiner, however, misinterprets this passage as disclosing that the sound is associated with the *user's act* of pressing the button, i.e. the sound is representative of forward navigation from a first arbitrary state 1 to an incrementally next second state. *See* Examiner's Answer at p. 4 ("Peterson teaches assigning sounds to 'next state' and

[1] The Examiner's rejection seems to interpret the limitations of "indicating upwards navigation" and "indicating downwards navigation", in isolation, as not being unique, meaning that Vallone's teaching of a single transitional sound that plays when a user scrolls to another page in a programming guide, *regardless* of whether the user is navigating upwards or downwards, would read on *both* the first characteristic indicating upward navigation and the second characteristic indicating downwards navigation, were it not for the additional claim limitation that the first and second characteristics be different.

'previous state' tools at col. 27 lines 31-35 and lines 43-45.") Obviously, this is incorrect; the sound of a dog barking is not representative of a user pressing a "next" or "previous" state button, but is instead representative only of the *unique* transition between two *particular* states, or data points in a sequence. Thus, contrary to the Examiner's assertion, Peterson fails to disclose using different aural signals to reflect forward/backwards (or upwards/downwards) navigation through a hierarchical sequence of data.

The teachings of Petersen have nothing to do with those of Vallone. Obviously, the display sections of Vallone do not have various sounds or noises inherently associated the content displayed, the way that a dog standing (from a sitting position) may also be barking. Whereas, in Vallone a sound is generically associated with the *user's* action of moving from one graphic to another, Petersen merely teaches that the *content* of what is displayed by a forward sequence of images may have sounds associated with them, and that these sounds may be played when forward-navigating through the sequence of images.

Despite the apparent persuasiveness of this argument against the Examiner's rejection, the Board declined to consider it, on the sole basis that the argument was first raised in the applicant's Reply. As support for this action, the Board cited not the Code of Federal Regulations or MPEP procedures regarding appeals before the Board, but instead two court decisions that refused to consider arguments first raised in a reply brief filed in accordance with the Federal Rules of Civil Procedure. Had the Board looked to its own procedures, it would have found that they permit new arguments to be raised in a reply brief.

The Code of Federal Regulations merely prohibits an applicant from introducing new evidence or new amendments in a Reply brief in an appeal before the Board. *See* 37 C.F.R § 41.41. No rule prohibits an applicant from raising new arguments in a Reply, and in fact, the regulations acknowledges that an applicant is free to raise new arguments. *See Id.* at § 41.43 ("In addition, the primary examiner. . . may furnish a supplemental examiner's answer responding to *any new issue raised in the reply brief.*") *See also* MPEP at 1208-1209. (stating that the applicant is allowed a further reply to any supplemental brief responding to a new issue raise in the applicant's first reply) The Board's statement that to "permit Appellant to present such arguments would essentially prejudice the appellate process since the Examiner is not permitted

to reply for our benefit" and that the applicant "effectively waived" its argument by not first raising it in the appeal brief is simply incorrect.

The Code of Federal Regulations at §§ 41.41 and 41.43 appear to be dispositive of this issue. If new arguments were to be prohibited in a reply brief, that proscription would have appeared in 37 CFR § 41.41 (a). However, given that the only proscriptions when filing a reply brief are against new evidence and new amendments, and that 37 CFR § 41.43 outlines an express procedure on the contingency that a new argument is raised in a reply brief, the Board erred in refusing to consider the applicant's argument. Therefore, the applicant respectfully requests that the Board rehear the appeal in this matter and reverse the Examiner's rejection of claims 11-30.

Respectfully submitted,

June 30, 2009
Dated

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